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Gladys E. Morales Date: *September 29, 2005*

MAIL STOP AMENDMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

James A. Bono, Jr.

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Conf. No.: 1746

: Group Art Unit:

3676

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Appln. No.: 10/663,000

: Examiner:

Vishal A. Patel

Filing Date: September 16, 2003

: Attorney Docket No.: **6652-43U1**

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Title: CLIP GASKET TERMINATION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection mailed June 29, 2005 in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated on the attached remarks.

Respectfully submitted,

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29 Sept. 2005 By: (Date)

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REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-16 are pending in the application. Claims 1-5, 9, 15 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,205,075 (Moyer) in view of U.S. Patent No. 767,763 (Reinvaldt). Claims 6-8 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Moyer and Reinvaldt as applied to the claims above, and further in view of U.S. Patent No. 4,986,033 (Weil). Claims 1-5 and 10-14 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Moyer as applied above in further view of U.S. Patent No. 4,156,533 (Close *et al.* hereafter “Close”).

Claim Rejections 1-5, 9 and 15-16: U.S. 5,205,075 (Moyer) in view of U.S. No. 767,763 (Reinvaldt)

With respect to claim 1, the Examiner asserts that “Moyer discloses a termination of a flexible hollow gasket (90) mounted to close a gap between an oven door 150 and an oven face (face of 140) surrounding an oven mouth (mouth of 140) and facing the oven door.” (Emphasis added). The Examiner further asserts that the gasket includes “a tubular member having first and second opposing ends (ends of 90), ... and a plurality of fasteners 10 extending through the flexible wall and outwardly from the flexible wall ...” and that “two of the fasteners are located immediately adjacent the first and second ends (joint formed by the ends of the gasket 90 and retained by the clips 10 on an oven door 150) to connect to the oven door or the oven face by the fasteners.” There is no such disclosure in Moyer. Moyer is devoid of any reference either in the text or in the drawings to a gasket termination or gasket ends. Furthermore, U.S. Patent No. 4,822,060, which is the only other document incorporated by reference into Moyer (see at col. 5, lines 39-41 of Moyer), is also devoid of any reference to a gasket termination or ends. While gasket 90 is probably formed by joining two ends together, Moyer does not disclose or otherwise address a termination and neither discloses nor suggests where such joining is located with respect to the clips or how it is made or the structure of the ends that are joined.

The Examiner thereafter expressly admits that “Moyer fails to disclose that the first end of the flexible wall is at least partially collapsed to form a male end, the second end of the wall is left uncollapsed to form a female end, the male end is adjustably received within the female end to form a joint engaging the first and second ends together to form the closed loop, and the joint being held together by the fasteners immediately adjoining each of the first and second ends of

the wall received in the two other spaced openings in the oven door or in the oven face" as is expressly set forth in claim 1. However, the Examiner asserts that each of these gasket end descriptions is a "product by process" or "method" limitation which is "given no patentable weight." In fact, these are structural limitations. They define the state of the ends of "a tubular member" having "a resiliently flexible wall....", not any process or method of reaching that state. Furthermore, it is a state of the ends before being "...adjustably received ... to form a joint...to form a closed loop...." Accordingly, these limitations cannot be ignored and to admittedly do so makes these rejections *prima facie* unsupported.

Next, the Examiner asserts that Reinvaldt further discloses "a gasket having a first male end (F), a female end (G) and two fasteners (Two of C adjacent to G and F as seen in Fig. H) adjacent the ends that hold a joint formed by the male and female ends". The Examiner further asserts that "(i)t would have been obvious . . . to configure the first and second ends of Moyer to be a male end and a female end, respectively" as taught by Reinvaldt, to provide a joint without a lump (Page 1, column 2, lines 75-85 of Reinvaldt) or an alternative way of joining a member to form a loop."

The characterization of "C" in Reinvaldt as "fasteners" is unsupported. C identifies each of a series of "holes" in a web B holding together ends of two tubular portions A of the Reinvaldt gasket. A hole is the absence of something. Indeed, the holes are the openings into which a single, real "fastener", namely bolt D in Reinvaldt, is inserted. While an examiner is permitted to broadly construe the claim language, such construction must have some relation to reality. "Claims must be given their broadest reasonable interpretation" and "the words of a claim must be given their plain meaning." (MPEP 2111, emphasis added) In asserting that holes "C" are fasteners, the Examiner has done neither.

Initially, Moyer and Reinvaldt are not properly combinable under 35 U.S.C. § 103. Moyer is directed to a flexible oven gasket including a tubular member with a resiliently flexible wall formed at least substantially by intertwined fibrous yarns. While Reinvaldt is directed to a gasket, it is one that is cast in one piece (lines 30-35) from a soft, deformable metal and used to join together lengths of pipe or tubing without leakage. The references disclose different gasket constructions of different materials made in different ways and in different configurations for

different end uses. The only teaching or suggestion to select and combine portions of such features from all other prior art gaskets and gasketing is the teaching of the present application.

Furthermore, the Examiner has misconstrued the teaching of Reinvaldt to justify the combination. The Examiner asserts that the male/female configuration taught by Reinvaldt would provide a joint without a lump" However, the swaging down and enlarging each of the ends taught by Reinvaldt does more than shape the ends. It also thins the metal. The lump is avoided by avoiding "the presence at that point of a greater mass of metal." (Reinvaldt, page 1, right col. lines 83-84.) The only way "a greater mass of metal" can be avoided at the joint is to thin the overlapping tubular ends F and G. The tubular wall of the Moyer reference cannot be so thinned so that aspect of Reinvaldt (the configuration) cannot be duplicated in Moyer. The fact that Reinvaldt discloses an alternate way of forming a loop, the alternate justification for the combination given by the Examiner, is not a teaching or suggestion. There are many ways to form a gasket loop and the many differences between the Moyer and Reinvaldt gaskets would lead one of ordinary skill to prior art oven gasket terminations like those disclosed in the present application, rather than the Reinvaldt termination.

Next, no matter how it is interpreted, Reinvaldt teaches no more than the prior art practice of securing the ends of an oven gasket together by a fastener through the overlapped ends. This is described in paragraph [0006] on page 1 of the present application. The bolt D of Reinvaldt is the fastener and holds the gasket ends together by direct passage through the holes C in the overlapped ends of the web portion B of the Reinvaldt gasket. There is no teaching or suggestion to try to secure the ends of the Reinvaldt gasket together simply by crushing together the overlapped tubular ends F and G. If the web B were not present, the fastener (bolt D or its equivalent) would have to be passed through the overlapped gasket ends F and G in some way, for example by the provision of overlapping holes in the overlapping ends F and G. Following the teachings of Reinvaldt in Moyer would simply result in the known and admittedly prior art practice of joining the ends of a gasket together by passing a single fastener through both of the overlapped ends. Indeed, in Moyer, one of the clips 10, which are described as types of staples, could be used in place of the conventional staples used in the prior art. This construction is still different from the language of claim 1 which states "the joint being held together by the fasteners

immediately adjoining each of the first and second ends of the wall **received in two of the spaced openings.**" (Emphasis added) The ends would be held together by the one staple/clip.

Nowhere are prior art rejections of new claims 15 and 16 addressed. The rejection made is identical to the rejection stated for claims 1-5 and 9 before claims 15 and 16 were added.

Claims 15 and 16 added structure ("the first end is secured in the collapsed position apart from being received in the second end" and "further comprising a securement mounted to the first (end) so as to maintain the first end in an at least partially collapsed condition") neither disclosed nor suggested in Moyer or Reinvaldt.

Claim Rejections 6-8: U.S. 5,205,075 (Moyer) in view of U.S. No. 767,763 (Reinvaldt) and U.S. No. 4,986,033 (Weil)

The Examiner has also rejected claims 6-8 under 35 U.S.C. 103(a) as being unpatentable over Moyer and Reinvaldt as applied to the claims above, and further in view of U.S. Patent No. 4,986,033 (Weil). Claims 6-8 are dependent from Claim 1 through claim 5. The Examiner does not rely upon Weil to overcome the above explained infirmities of the proposed combination of Moyer and Reinvaldt. Weil also says nothing about any joint or termination.

Claim Rejections 1-5 and 10-14: U.S. 5,205,075 (Moyer) in view of U.S. No. 4,156,533 (Close)

The Examiner again expressly admits that Moyer does not disclose the first end of the flexible wall being at least partially collapsed to form a male end and the second end of the wall being left uncollapsed to form a female end or disclose that the male end is adjustably received within the female end to form a joint engaging the first and second ends together to form the closed loop. The Examiner asserts that Close discloses "a gasket having a core (40), an outer jacket (42), a male end (end of the core 40 in figure 6) and a female end (end of the outer jacket 42) [where] the male end [is] inserted into the female end to form a joint" The Examiner argues that it would have been "obvious to configure the first and second ends of Moyer to be a male end formed by the core and a female end formed by the outer jacket, respectively as taught by Close, to provide a gasket that is continuous (column 3, lines 56-62 of Close) or an alternative way of joining a member to form a loop."

Close is directed to a high temperature gasket having a first and second ends. On the first end, the core material 40 is extended outward from the outer wall 42. On the second end, the outer wall 42 is extended outward from the core material 40 (Fig. 6). The first end is inserted into the second end to form a joint 44 (Fig. 7). An additional piece of sheathing 46 can be included to further strengthen the joint 44 (Fig. 8).

Applicant does not transverse the combination as proposed by the Examiner. However, even if Moyer and Close were combined, the combination would fail to satisfy several elements of claim 1. First, if the male end were formed by an extension of the core beyond the jacket, the male end would not be “partially collapsed”. The gasket end would be thinned by the removal/deletion the outer jacket material rather than collapsed. The male end formed by the resilient wire tube core of Moyer would be as fully opened it could possibly be and, if inserted into an empty end of the braided glass jacket, would be at least as fully opened as it is elsewhere in the uncollapsed gasket.

Finally, the combination still does not satisfy the requirement of claim 1 for a joint being held together by fasteners immediately adjoining each of the first and second ends of the wall received in two spaced openings in an oven face or oven door receiving the gasket. Close does not disclose or suggest the use of any type of fastener for holding together a joint that would also be received in spaced openings. Close discloses only a sleeve 46 for strengthening the joining 44 by wrapping the sleeve 46 around the joint 44 of the gasket (col. 3, line 67- col. 4, line 1). Close further discloses applying an adhesive but only to the ends of the extruded core (col. 5, lines 40-42) or to attach a shielding coating of aluminum foil (col. 6, lines 24-30). Even the latter is disclosed to be volatized at temperature. Moyer says nothing about a joint. The clips 10 in Moyer are arranged only according to the arrangement of the holes 160 and the oven door 150 without regard to location of a joint between two ends of the gasket. As was mentioned above, there is a prior art practice of stapling together the overlapped ends of an oven gasket. That construction might lend itself to the Examiner’s proposed combination of Moyer and Close but again, it suggests the use of a Moyer clip/staple through the overlapped ends to secure those ends together.

The rejections are unsupported and should be withdrawn.